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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,556	11/24/2003	William C. Sandlin	003888.00002	1264

22907 7590 10/28/2004

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

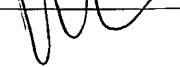
LOPEZ, FRANK D

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,556	Applicant(s) SANDLIN, WILLIAM C. 	
	Examiner F. Daniel Lopez	Art Unit 3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37,52,61 and 62 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21,22,24-35,37,52,61 and 62 is/are rejected.
- 7) ☒ Claim(s) 23 and 36 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/24/03</u> | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 112

Claims 25-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25 line 2 "said plurality of second positioning system pistons", claim 29 line 6 "said second positioning pistons" and claim 33 line 6 "one of said pistons of said second positioning system" are confusing, since nowhere has a plurality of second positioning pistons been previously claimed (claim 21 line 7-8 claims "a second positioning system including: at least one piston", not a plurality of pistons).

In claim 27 line 1-2 "each said stroke limiting member" is confusing since this element was deleted from claim 21 (which claim 27 depends from). In claim 27 line 2-3 "a respective one of said fluid supply members" is confusing, since nowhere has a plurality of fluid supply members been previously claimed (claim 21 line 13 claims "at least one fluid supply member", not a plurality of pistons).

In claim 33 line 3 "said head assembly" is confusing since this element was deleted from claim 21 (which claim 33 depends from).

Claims not specifically mentioned are indefinite, since they depend from one of the above claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22 24-28, 37 and 61 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Pelton. Piston 81 and housing 74, 77 form part of the second positioning system. Pistons 84 and 90 form part of the first positioning system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 52 and 62 are rejected under 35 U.S.C. § 103 as being unpatentable over Pelton. Pelton discloses a multi-stroke fluid cylinder comprising a positioning system including a plurality of movable pistons (90, 84, 78) located within a cylindrical housing, extending substantially parallel to a length of the housing; a fluid supply member (91) extending substantially parallel to a length of the piston, for introducing fluid between adjacent pistons (84, 90); an additional fluid supply member including a hollow cylindrical member (91), extending thorough a center of one (90) of the pistons, for introducing fluid between adjacent pistons (78, 84); with a plurality of tethering members (92, 89) securing respective adjacent pistons, to limit movement between respective adjacent pistons; but does not disclose that there is a plurality of fluid supply members; or that the additional fluid supply member extends thorough a center of a plurality of pistons.

Each of the pistons, with associated fluid supply member and tether, of Pelton, defines a preselected distance, through which an output member (83) can be moved. It would have been obvious at the time the invention was made to one having ordinary skill in the art to add another piston, with associated fluid supply member and tether, to the positioning system of Pelton, through which the additional fluid supply member extends; for the purpose of an adding additional preselected distance.

Claims 21, 33-35, 37 and 61 are rejected under 35 U.S.C. § 103 as being unpatentable over Audemar et al in view of Pelton. Audemar et al discloses a multi-stroke fluid cylinder comprising first and second positioning system for moving a positioning member a preselected distance; with the first positioning system including a single piston (2); the second positioning system including a plurality of movable pistons (1, 8), with a tubular fluid supply member (7), for introducing fluid at a first pressure against one (8) of the pistons of the second positioning system; a stroke limiting member (6) secured to a terminal end of the fluid supply member; wherein the positioning member has a piston rod (connected between 3 and 1) attached to one of the pistons (1) of the second positioning system, adjacent and extending through a head assembly (9); wherein a stroke limiting shaft is secured to another of the pistons (8) of the second positioning system, and extends through the one piston; but does not disclose that the first positioning system includes a plurality of pistons, that the fluid supply member extends through at least one of the pistons of the first positioning system; or that the pistons of the first positioning system are each tethered to at least one immediately adjacent piston.

Pelton teaches, for a multi-stroke fluid cylinder comprising first and second positioning systems for moving a positioning member a preselected distance; with the first positioning system including a piston (84); the second positioning system including a plurality of movable pistons (78, 81), with a tubular fluid supply member (88), for introducing fluid at a first pressure against one (e.g. 78) of the pistons of the second positioning system; a stroke limiting member (89) secured to a terminal end of the fluid supply member; that the first positioning system includes a second piston (90), through which the fluid supply member extends; and that the pistons of the first positioning system are each tethered to at least one immediately adjacent piston (by 92, 89), for the purpose of adding additional preselected distances.

Since Audemar et al and Pelton are both from the same field of endeavor, the purpose disclosed by Pelton would have been recognized in the pertinent art of Audemar et al. It would have been obvious at the time the invention was made to one having ordinary skill in the art to add a second piston to the first positioning system of

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Audemar et al, through which the fluid supply member extends; with the pistons of the first positioning system each being tethered to at least one immediately adjacent piston, as taught by Pelton, for the purpose of adding additional preselected distances

Conclusion

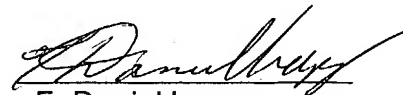
Claims 23 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 29-32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

I will be moving in November 2004, to the New PTO campus. When I move, my new phone number will be 571- 272-4821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez
Primary Examiner
Art Unit 3745
October 25, 2004